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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,229	03/16/2004	Tatsuya Hojo	5576-158	2013

7590 05/11/2006

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EXAMINER	
STITZEL, DAVID PAUL	
ART UNIT	**PAPER NUMBER**
1616	

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/801,229	HOJO ET AL.	
	Examiner	Art Unit	
	David P. Stitzel, Esq.	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

OFFICIAL ACTION

Restriction/Election

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-4 and 9 are drawn to a sex pheromone sustained release dispenser, as classified in class 424, subclass 408.

II. Claims 5-8 are drawn to a method for controlling an insect pest, as classified in class 424, subclass 405.

Inventions I and II are related as a product and a method of using said product, respectively. The inventions can be shown to be distinct if either or both of the following can be shown that: (1) the method of using the product as claimed can be practiced with another materially different product; or (2) the product as claimed can be used by another method that is materially different from the instantly claimed method of using said product. See, MPEP § 806.05(h). In the instant case, a product as claimed in Invention I can be used by another method that is materially different from the method claimed in Invention II. For example, as opposed to using said sustained release dispenser of sex pheromone substances for controlling an insect pest as claimed in Invention II, said sustained release dispenser of sex pheromone substances, as claimed in Invention I, may alternatively be incorporated into a perfume, as classified in class 424, subclass 401, or used for impregnating a female undergarment cloth, as classified in class 424, subclass 402. See e.g., U.S. Patent 5,278,141 and U.S. Pre-Grant Patent Application Publication 2005/0235400.

Because these inventions are independent and distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the prior art search required for each respective invention would be divergent, thereby causing an undue search burden.

As a result, restriction for examination purposes as indicated is proper. Applicants are therefore required under 35 U.S.C. § 121 to elect a single invention for prosecution on the merits.

Conclusion to Restriction Requirement

The Examiner has required restriction between product and methods of using claims. Where Applicants elect claims directed to a product, and the product claim is subsequently found allowable, withdrawn methods of using that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Methods of using claims that depend from or otherwise include all the limitations of the patentable product claim will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined methods of using claims will be withdrawn, and the rejoined methods of using claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §§ 101, 102, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and methods of using claims may be maintained. Withdrawn methods of using claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the methods of using claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the

right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See MPEP § 804.01.

If claims are added after the election, Applicants must explicitly indicate which claims are readable upon the elected species. See MPEP § 809.02(a). Amendments submitted after final rejection are governed by 37 CFR 1.116, whereas amendments submitted after allowance are governed by 37 CFR 1.312.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named Inventors is/are no longer an actual Inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

A telephone call was made to the attorney of record, namely Mr. F. Michael Sajovec, Esq., on May 8, 2006, to request an oral election to the above restriction requirement, but did not result in an election being made.

Contact Information

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to David P. Stitzel, M.S., Esq., whose telephone number is 571-272-8508. The Examiner can normally be reached on Monday-Friday, from 7:30AM-6:00PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Johann Richter, Ph.D., Esq., can be reached at 571-272-0646. The central fax number for the USPTO is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published patent applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished patent applications is only available through Private PAIR. For more information about the PAIR system, please see http://pair-direct.uspto.gov. Should you have questions about acquiring access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 2, 2006

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